

REMARKS

Applicants appreciate the consideration of the present application afforded by the Examiner. Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, and 14 are pending. Claims 1 and 7 are independent. Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

Disqualified Art Under 35 U.S.C. § 103(c)

In the Office Action, the Examiner has rejected claims 5 and 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,956,593 to Gupta et al. (“Gupta”). However, Gupta qualifies under the § 103(c) exception since the reference and the instant application are commonly assigned to Microsoft Corporation. Therefore, Gupta is not available as prior art under § 103 and the currently applied rejection of claims 5 and 11 under § 103(a) is not valid. *See M.P.E.P. § 2146; 35 U.S.C. § 103(c)(1).*

Applicants note that Gupta may only potentially be used as prior art under § 102(e) in rejecting the claims. Accordingly, if Gupta fails to disclose every element of a claim, Gupta is not available for a rejection under § 103(a) either alone or in combination with other prior art. Applicants respectfully submit that Gupta at least fails to anticipate each claimed element of independent claim 1 and is therefore not available as statutory prior art.

Interview Summary

Applicants appreciate the time afforded by the Examiner in conducting the Interview on November 30, 2007. During the Interview, Applicants presented arguments that Gupta falls under the § 103(c) exception, as discussed above, and that Gupta fails to teach all of the claimed elements of independent claim 1. Specifically, Gupta at least fails to teach “*obtaining a set of annotated documents that is a subset of the plurality of annotated documents based on a result of said searching step*”. At best, Gupta appears to teach querying annotations to obtain a set of annotations which meet the search criteria, not a set of the annotated documents themselves.

The Examiner agreed, pending a further review of the reference, that Gupta did not appear to teach the aforementioned limitation of independent claim 1. He indicated

that upon formal submission of the arguments presented in the Interview the § 102(e) rejection would likely be obviated. Applicants' arguments are formally entered through this Reply.

Claim Rejections - 35 U.S.C. §102

Claims 1, 2, 4, 7, 8, 10, 13, and 14 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Gupta (USP 6,956,593). Applicants submit the Examiner has failed to establish a *prima facie* case of anticipation and traverse the rejection.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. §102, the cited reference must teach or suggest each and every element in the claims. *See M.P.E.P. §2131; M.P.E.P. §706.02.* Accordingly, if the cited reference fails to teach or suggest one or more claimed elements, the rejection is improper and must be withdrawn.

Independent claim 1 recites:

A method for visually organizing collections of annotated Web-based documents, comprising the steps of:

(a) receiving a plurality of annotated documents, each of the annotated documents including a Web-based document associated with corresponding annotation data;

(b) including values of at least one attribute of the annotation data for each of the plurality of annotated documents in at least one searchable annotation database;

(c) searching the values of the at least one attribute in the at least one annotation database according to search criteria;

(d) obtaining a set of annotated documents that is a subset of the plurality of annotated documents based on a result of said searching step; and

(e) displaying a thumbnail image for at least one annotated document in the obtained set of annotated documents.

Applicants submit that Gupta fails to teach or suggest all of the limitations of independent claim 1.

Gupta is directed to a user interface for annotating media content, such as streaming video, by creating annotations pertaining to specific temporal locations and/or ranges. The user interface is also used for retrieving and viewing the annotations. *See col. 2, lines 18-53.* As seen in Gupta, Figure 4, each annotation entry 180 contains data such as author of the annotation, the time range, the content of the annotation, and a

media content identifier 200 which indicates the particular media content to which the annotation entry corresponds. *See col. 9, lines 26-28.*

Furthermore, Gupta teaches a dialog box 370 that allows a user to query the annotations. Figure 12 shows this dialog box, whereby a user may enter search criteria into a search field 386. The user may also select which annotation sets to search in field 376. Gupta discloses that the annotations in the annotation sets may correspond to more than one target stream. Gupta also discloses that the user may select annotations sets to query for a first target stream, and may select annotations sets to query for a second target stream. *See col. 16, lines 19-30.* Furthermore, Gupta states that the query can be limited to only those annotations that correspond to a target stream identified in a target display field 372 in the dialog box 370. *See col. 16, lines 31-42.*

In summary, Gupta may search the annotations of one specific media stream or may retrieve annotations from multiple streams. Figures 15-18 show the results of such an annotation search, whereby the annotations which meet the search criteria are displayed in the annotations field 446.

However, although Gupta appears to disclose retrieving a set of annotations which meet the search criteria, Gupta fails to teach or suggest obtaining a set of *annotated documents* based on the search criteria. In other words, the results of the search in Gupta merely reflect which *annotations* meet the search criteria. Although each retrieved annotation meeting the search criteria may be associated with a particular target stream (e.g., the annotation may include data pointing to the target stream it annotates, *see Fig. 4*), Gupta fails to suggest obtaining a set of such target streams. In the instant invention, attributes in an attribute database are searched based on search criteria and a set of annotated documents that is a subset of the plurality of annotated documents are obtained based on a result of said search. Owing to this feature of the instant invention, a user may acquire a set of annotated documents with annotations having a certain attribute value, which may be specified by the user. Gupta cannot teach at least this feature of independent claim 1.

Therefore, at least because Gupta fails to teach or suggest each and every claimed element, independent claim 1 is distinguishable from the prior art. Claim 7 is comparable to independent claim 1 at least in that it claims features which are not shown by the prior

art at least for reasons argued above with respect to claim 1. Dependent claims 2, 4, 8, 10, 13, and 14 are also distinguishable from the prior art at least due to their dependence from claims 1 and 7, directly or indirectly. Accordingly, Applicant respectfully requests that the rejection of the claims under 35 U.S.C. § 102(e) be withdrawn.

Claim Rejections - 35 U.S.C. §103(a)

Claims 5 and 11 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gupta. This rejection is not valid for the reason that Gupta does not qualify as prior art under the § 103(c) exclusion, being commonly assigned with the instant invention. Therefore, Applicants submit that claims 5 and 11 are patentable over Gupta and are in condition for allowance.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Notice of same is earnestly solicited.

If the Examiner has any questions concerning this application, please contact John R. Sanders (Reg. No. 60,166) at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

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